

to eliminate this rejection, a better reference to this feature of the present invention being further defined in Claim 2 already, making this reference in Claim 1 somewhat redundant.

As to the rejections of Claims 1 and 2 based upon the combined references of Airey, Jr., Kirkpatrick and Strode, Applicant respectfully disagrees with this rejection. In order to substantiate these rejections, Examiner must meet the following standards for an obviousness rejection.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of its success must both be found in the prior art, and not based on the applicant’s disclosure.” MPEP § 2142.

Courts have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

Airey, Jr. does teach a flexible interior bag structure, but in no way references any means of attaching the lower portion of that bag to a “lower portion of said primary golf bag when said flexible sleeve is expanded...” Airey, Jr. is specifically claimed and defined as a bag which is inserted within the primary bag and the lower portion merely dangles within the primary bag, and no reference is made to the base having any relative size or perimeter to allow the bottom 21 to be inserted within the top opening 22, which lacks any further definition at all, except for the upper annular portion 24, and four apertures 37, which provide a strap attaching means to connect the annular portion to the top of the primary golf bag. Case law makes it clear that the best defense against the subtle but powerful attraction of a hind-sight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine the prior art

references. In re Demiczak, 175 F.3d 994, 999 (Fed.Cir. 1999).

As to the Strode reference, it appears that this is the reference used by the Examiner to identify the feature of the present invention, supposedly providing a prior reference to ...”the rigid lower cylindrical ring attached to said lower end of said fabric sleeve having a lower floor segment and an outer perimeter with *a formed lower attachment hook attaching to a lower attaching means*, said upper attaching means attaching to an upper portion of said primary golf bag and *said lower attaching means attaching to a lower portion of said primary golf bag when said flexible sleeve is expanded...*”. Strode identifies some form of angle adjustment member 23 to the carrier body and running through openings 84, 86,88 in the fabric shell, which is intended to adjust the angle of the Strode golf bag as it attaches to the eyelet 56a of the clip 56 which attaches the waistband strap 22 to the golfer. This appears to be an improper “reading-on” of Strode to the present invention claimed features. An Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*. Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed..Cir. 1998).

As to the claim by the Examiner that the bag having a taper with the bottom smaller than the top as indicated in Kirkpatrick, that may be so, but there is no applicable function to the alleged “top-larger-than-the-bottom” feature, as in Claim 2, which allows for the present invention to be collapsed for compact storage within a primary golf bag.

In addition, Strode makes no reference to being used with another bag. Kirkpatrick and Airey, Jr. are intended for insertion within a primary golf bag, and removal from the inside of the bag

when used for short club play, not reflecting any claimed attachment to a primary golf bag at an upper and lower end for stable vertical attachment to a primary golf bag or to a golf cart.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In Re Geiger*, 815 F.2d 686, 2 U.S.P.Q. 2d 1276 (C.A.F.C. 1987); *In Re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (C.A.F.C. 1988). Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art. *In Re Vaack*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (C.A.F.C. 1991). The art upon which the rejections are based do not fulfill this requirement and are clearly distinguishable. Applicant respectfully requests withdrawal of the outstanding rejection based upon 35 USC § 103(a) and allow the claims as amended to proceed to allowance and issue.



AMENDMENTS

To the Specification, the paragraph beginning page 4 line 10 through page 5, line 2:

A collapsible and detachable auxiliary golf club bag **10** for carrying an assortment of short play golf clubs **200**, shown in FIGS. 1-5 of the drawings, attaching to a primary golf club bag **200**, **100**, golf cart or other item, comprises essentially a cylindrical flexible fabric sleeve **20** defining an inner cavity **22** adapted to contain the short play golf clubs **200**, the fabric sleeve **20** having an upper end **24**, a lower end **26** and an outer surface **28**, a shoulder strap **30** and a hand grip strap **40** attached to the outer surface **28** of the fabric sleeve **20**, a rigid upper cylindrical ring **50** attached to the upper end **24** of the fabric sleeve **20** having a central opening **52** and an outer perimeter surface **54** with a formed upper attachment hook **56** with an upper attaching means **70**, a rigid lower cylindrical ring **60** attached to the lower end **26** of the fabric sleeve **20** having a lower floor segment **62** and an outer perimeter surface **64** with a formed lower attachment hook **66** with a lower attaching means **80**, the upper attaching means **70** attaching to an upper portion **102** of the primary golf club bag **100** and the lower attaching means **80** attaching to a lower portion **104** of the primary golf club bag **100** when the flexible sleeve **20** is expanded, as shown in FIG. 5, the flexible sleeve **20** collapsing for storage with the lower cylindrical ring **60** fitting within the upper cylindrical ring **50** for compact storage, FIG. 4.

To the Claims:

1. (Currently Amended) A collapsible and detachable auxiliary golf club bag for carrying an assortment of short play golf clubs, the auxiliary golf club bag attaching to a primary golf club bag or golf cart, comprises essentially:

a cylindrical flexible fabric sleeve defining an inner cavity adapted to contain said short play golf clubs, said fabric sleeve having an upper end, a lower end and an outer surface, a shoulder strap and a hand grip strap attached to said outer surface of said fabric sleeve;

a rigid upper cylindrical ring attached to said upper end of said fabric sleeve having a central opening and an outer perimeter with a formed upper attachment hook attaching to an upper attaching means;

a rigid lower cylindrical ring attached to said lower end of said fabric sleeve having a lower floor segment and an outer perimeter with a formed lower attachment hook attaching to a lower attaching means, said upper attaching means attaching to an upper portion of said primary golf bag and said lower attaching means attaching to a lower portion of said primary golf bag when said flexible sleeve is expanded, said flexible sleeve collapsing for storage with said lower cylindrical ring fitting within said upper cylindrical ring for compact storage in said primary golf bag.

2. (Original) The auxiliary golf club bag, as disclosed in Claim 1, further comprising:

said upper cylindrical ring has a perimeter larger than a perimeter of said lower cylindrical ring, said upper cylindrical ring receiving said lower cylindrical ring when said auxiliary bag is collapsed, thereby allowing said auxiliary golf bag to be compacted for storage;

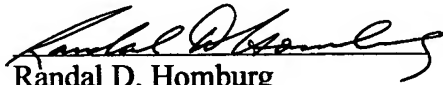
said upper attaching hook and said lower attaching hook are aligned in a vertical axis placing said auxiliary bag parallel to said primary golf bag when attached;

said upper cylindrical ring and lower cylindrical ring are suspended in vertical alignment by said flexible sleeve to position said short game golf clubs vertically within said auxiliary golf bag.

CONCLUSION

The applicant submits that the above-noted amendments and remarks put the application in condition for allowance. Applicant therefore respectfully requests that the Examiner withdraw the outstanding objections and rejections contained in the Office Action of 10/05/05, and pass this application to issue. Applicant expresses their appreciation to the Examiner for Examiner's attention and courtesy.

Respectfully submitted;



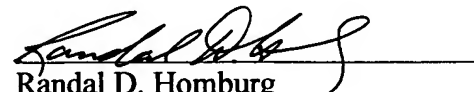
Randal D. Homburg
Registration No. 41,847
P.O. Box 10470
Midwest City, OK 73140-1470
Phone: (405) 769-9281
FAX: (405) 769-9288
E-mail: rhomburg@cox.net

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on the 25th day of November 2005.



Randal D. Homburg
Reg. No. 41,847